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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/508,617	03/14/2000	KOJI IDEI	000225	8477

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EXAMINER	
FERGUSON, LAWRENCE D	
ART UNIT	**PAPER NUMBER**
1774	

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/508,617	IDEI ET AL.	
	Examiner	Art Unit	
	Lawrence D Ferguson	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3-5* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 3-5* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Appeal Brief

1. This action is in response to the Appeal Brief mailed April 28, 2004. Examiner regrets the untimely reopening of the case and withdraws the previous rejections to further prosecute the claimed invention. Claims 1 and 3-5 are pending in this case.

Claim Rejections – 35 USC § 103(a)

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1 and 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujioka et al. (U.S. 4,279,961) in view of Tanaka et al. (U.S. 5,252,184).

Fujioka discloses a recording material with a base sheet (abstract) where a coating is applied to the base sheet comprising cationic resins, a surface resistivity of 10^6 to 10^{10} ohms and 2 to 20 g/m^2 by dry weight (column 5, lines 33-44) where the resistivity is higher in an atmosphere of lower humidity (column 1, lines 39-48). Fujioka further discloses coating a paper (column8, lines 9-11). Although Fujioka does not explicitly teach making the paper from pulp, it would have been obvious for the paper to contain pulp because paper is conventionally made from pulp. Although Fujioka is silent

towards a cation equivalent, the claimed cation equivalent is directly related to the specific cationic resin used. Since Fujioka uses the same cationic resin as Applicant, the cationic equivalent of Fujioka's recording material would be expected to be the same as claimed, absent any evidence to the contrary. In instant claim 1, the phrase "as measured by colloidal titration method" introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given no patentable weight in product claims. Although Fujioka teaches the recording material can be used in copying machines and other printers (column 1, lines 9-19) the reference does not explicitly disclose it is used for ink jet and electrophotographic recording. The phrase, "for ink jet and electrophotographic recording" is an intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458, 459 (CCPA 1963).

Claim Rejections – 35 USC § 103(a)

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fujioka et al. (U.S. 4,279,961) in view of Shepherd (U.S. 4,207,142).

Fujioka is relied upon for claim 1 as above. Fujioka does not teach the paper having a neutral rosin sizing agent or alkenyl succinic anhydride as an internal sizing agent. Shepherd teaches paper sizing materials consisting of rosin (column 1,lines 18-20) and alkenyl succinic anhydride sizing agents (column 2,lines 45-63). It would have been obvious to one of ordinary skill in the art to include a rosin or alkenyl succinic anhydride sizing agent in the paper of Fujioka because Shepherd teaches the sizing agents impart to paper good resistance to acidic liquids and do not detract from the strength of the paper and can increase the strength of the finished sheets (column 13, lines 48-60).

Response to Arguments

5. Applicant's arguments to rejection under 35 U.S.C. 103(a) as being unpatentable over Fujioka et al. (U.S. 4,279,961) in view of Tanaka et al. (U.S. 5,252,184) have been considered and Tanaka is withdrawn because it does not explicitly teach a cationic resin. Applicant argues Fujioka's coating composition is not the cationic resin which is claimed because the cationic resin is only one possible component of the coating composition and the most important ingredients are zinc oxide powder and coloring agent. As Applicant indicated, Fujioka does disclose cationic resin in the coating composition. The amount of the cationic resin is of little relevance because Applicant

does not claim an amount of cationic resin used in adhering to the support. Additionally, Applicant uses the claim language comprising, which encompasses additional materials not claimed in the instant claimed invention. Applicant further argues no percentage or amount of cationic resin is disclosed anywhere in the patent. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a cationic resin percentage or amount) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant argues Fujioka does not disclose a cationic equivalent measure by colloidal titration method. Although Fujioka is silent towards a cation equivalent, the claimed cation equivalent is directly related to the specific cationic resin used. Since Fujioka uses the same cationic resin as Applicant, the cationic equivalent of Fujioka's recording material would be expected to be the same as claimed, absent any evidence to the contrary. In instant claim 1, the phrase "as measured by colloidal titration method" introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. Further, process limitations are given no patentable weight in product claims.

Arguments towards the Tanaka reference are moot due to the reference being withdrawn. Applicant argues the surface resistivity and density range are not met by Fujioka because the surface resistivity of Fujioka abuts the claimed surface resistivity and the reference does not have specific examples falling within the claimed ranges. A

prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. Titanium Metals Corp. of America v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). Additionally, Fujioka teaches the resistivity can be varied depending on the atmospheric humidity and moisture content (column 1, lines 39-48).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LF

Lawrence Ferguson
Patent Examiner
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RENA DYE
PRIMARY EXAMINER

Supervisory A.U. 1774